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Paper No. 37

Appeal No. 91-0984

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ON BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte Gilbert P. Hyatt

Application for Patent filed December 3, 1987, Serial
No. 07/123,659, which is a continuing application of previously
filed applications. Projection Display System.

Gilbert P. Hyatt pro se.

Primary Examiner - James J. Groody.
Examiner - M. R. Powell.

Before Craig, Lindquist and Lynch, Examiners-in-Chief.

Lindquist, Examiner-in-Chief.

This appeal is from the refusal of the examiner to
allow claims 2, 7 through 9, 22 through 24, 32, 73, 74, 76, 77,
82 through 84 and 91 through 149, all the claims in this
application.

The invention pertains to a television system as is
apparent from a consideration of illustrative claim 7, reproduced
below.

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7. A television system comprising:
an illumination source for generating source illumination;
a first electrical control device for generating a first electrical television control signal related to a first color;
a second electrical control device for generating a second electrical television control signal related to a second color;
a first illumination control device for controlling the source illumination to generate a first television display image having a first color under control of the first electrical television control signal generated by said first electrical control device;
a second illumination control device for controlling the source illumination to generate a second television display image having a second color under control of the second electrical television control signal generated by said second electrical control device;
a fiber optic device for conducting the first television display image generated by said first illumination control device and the second television display image generated by said second illumination control device; and
a display surface for generating a multi-colored television display image in response to the first television display image conducted by said fiber optic device and the second television display image conducted by said fiber optic device.

No prior art references have been cited by the examiner.

Claims 7 through 9, 32, 73, 74, 75, 77, 82 through 84, 101, 103 through 107, 109, 110, 119, 120, 122, 124 through 126, 129 and 133 through 149 stand rejected under the first paragraph of 35 U.S.C. 112 as failing to satisfy the written description requirement thereof because it is alleged that the disclosure of this application as originally filed does not include the "combinations" now claimed.

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All the claims at bar stand rejected "under the equitable doctrine of laches" because the appellant allegedly delayed filing the present continuing application for about nine years after an application (Serial No. 860,277) having the same disclosure was filed.

Reference is made to the briefs and the answer for the respective positions of the appellant and the examiner.¹

OPINION

35 U.S.C. 112 Rejection

The three separate and distinct requirements of the first paragraph of 35 U.S.C. 112 are (1) written description, (2) enablement and (3) best mode.² Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 19 USPQ2d 1111 (Fed. Cir. 1991); In re Barker, 559 F.2d 588, 194 USPQ 470 (CCPA 1977). The written description requirement is satisfied if the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter; literal support in the specification for the claim language is not necessary. Vas-Cath Inc. v. Mahurkar, supra; In

¹ The examiner withdrew the final rejection of claims 115, 147 and 149 under the second paragraph of 35 U.S.C. 112 in the paragraph bridging pages 2 and 3 of the answer.

² The examiner expressly states at page 3 of the answer that the rejection under the first paragraph of 35 U.S.C. 112 is not based on the enablement or best mode requirements.

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re Kaslow, 707 F.2d 1366, 217 USPQ 1089 (Fed. Cir. 1983).

However, that the claimed subject matter may have occurred, might be thought to be possible from reading the disclosure or would have been obvious to the artisan is irrelevant insofar as the written description requirement is concerned. In re Barker, supra; In re Winkhaus, 527 F.2d 637, 188 USPQ 129 (CCPA 1975); In re Wohnsiedler, 315 F.2d 934, 137 USPQ 336 (CCPA 1963). An omnibus statement in a specification that various features may be combined does not necessarily satisfy the written description requirement.

The only issue with respect to the rejection under the first paragraph of 35 U.S.C. 112 before us today is whether the disclosure of the present application provides a written description of the subject matter of the claims at bar. Whether the appellant might be entitled to an earlier effective filing date under 35 U.S.C. 120 based upon one or more previously filed applications also satisfying the three separate and distinct requirements of the first paragraph of 35 U.S.C. 112 as to the subject matter of the claims at bar is for another day should intervening prior art be found.

The burden is initially upon the examiner to establish a reasonable basis for saying that the written description requirement is not satisfied. Vas-Cath Inc. v. Mahurkar, supra; In re Kaslow, supra. Here, the examiner in his answer vaguely

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refers to various "combinations" allegedly not originally disclosed which would not be enough to discharge his initial burden. However, the examiner at page 2 of the answer refers us to pages 6-9 of the final rejection for the "details of the rejection."

Looking at the final rejection, we have identified four "combinations" that are said to lack support in the disclosure and reproduce them as follows:

(1) In this application, although applicant has disclosed the features of using plural liquid crystal devices to provide a color image and using fiber optics to conduct the light from a single liquid crystal device, there is no specific statement similar to the example given above indicating that applicant contemplated using these two features together. (Sentence bridging pages 7 and 8)

(2) The features of using fiber optics and using lens [sic, lenses] are concluded to not be described as being combined using the same analysis. (page 8)

(3) The feature of fiber optics have one-to-one correspondence with segments has never even been stated or referred to in the specification. (page 8)

(4) The specification does not state that duty cycle control circuits or capacitors are to be used simultaneously with fiber optic conductors. (page 9)

Except for combination (4), the examiner does not relate the alleged deficiencies to any particular claim. As for combination (1), only rejected claim 107 is of that specificity although

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rejected claims 7, 9, 73, 76, 101, 103 through 106, 134 through 137, 147 and 149 include the combination in broader terms. Combination (2) appears in rejected claims 119, 124 and 125. Combination (3) including the "one-to-one correspondence" requirement does not appear in any of the rejected claims; however, rejected claims 73, 74, 76, 77, 82 through 84, 120, 122, 126, 129 and 133 through 149 do generally refer to fiber optics and control, electro-optic or liquid crystal device segments. Combination (4), as the examiner says, pertains to rejected claims 8, 32, 77, 109 and 110.

The appellant and the examiner seem to have ignored the fact that the originally filed claims are also part of the originally filed disclosure of this application. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976). Original claim 9, for example, includes the combination recited in most of the rejected claims we have grouped in combination (1), and original claim 30, for example, includes the "plural liquid crystal devices to provide a color image" and "fiber optics to conduct the light from a single liquid crystal device" of combination (1) and required by claim 107.

Original claims 61 and 62, for example, include the combination of fiber optics and lenses of combination (2)

As we noted before, none of the rejected claims calls for a "one-to-one correspondence" between the fiber optics and segments of a control, electro-optic or liquid crystal device. However, we note that original claim 25, which depends from claim 9 referenced before, is exemplary in reciting a segmented liquid crystal device in combination with fiber optics (claim 9).

None of the original claims specifies that the television system having fiber optic conductors also includes a duty cycle control circuit or capacitors of combination (4). However, we view the latter as details of the television system rather than a new combination. We find a description of these details at page 185, lines 25-28, page 186, lines 8-13, and page 187, lines 25-28, for example, of the specification as originally filed.

Accordingly, the rejection of certain of the claims at bar under the first paragraph of 35 U.S.C. 112 cannot be sustained.

Laches Rejection

The equitable defense of laches, as it pertains to patents, may arise when a patent owner unreasonable delays filing a suit for infringement to the material detriment of the alleged infringer. Chisum, Patents, Vol. 4, Matthew Bender & Company,

Inc., New York, 1990, pp. 19-159 et seq. Obviously, laches does not apply to an application pending in the Patent and Trademark Office under the Chisum definition. The examiner has not cited any case law in support of his position, and we are aware of none.

It appears to us that the appellant has done what is provided for in the statute and relevant rules and practice of the Patent and Trademark Office in filing the present continuing application. 35 U.S.C. 120 does not place a time limit on filing the continuing application; rather, all that is required in this regard to preserve an earlier effective filing date as to common subject matter is copendency or a continuous chain of copendency. While there is no prohibition to the delay in filing a continuing application, as in this case, an applicant runs the risk of intervening prior art. In that situation, an applicant would have to rely on the earlier filed application(s) under 35 U.S.C. 120 and would have the burden of demonstrating where each and every feature and combinations thereof of the claimed invention in the later filed application are disclosed in a manner that satisfies the three requirements of the first paragraph of 35 U.S.C. 112 in each and every previously filed application relied on in an attempt to antedate the intervening prior art.

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DECISION

The rejection of claims 7 through 9, 32, 73, 74, 76, 77, 82 through 84, 101, 103 through 107, 109, 110, 119, 120, 122, 124 through 126, 129 and 133 through 149 under 35 U.S.C. 112 and the rejection of claims 2, 7 through 9, 22 through 24, 32, 73, 74, 76, 77, 82 through 84 and 91 through 149 on the ground of laches are both reversed.

REVERSED

Gerry D. Craig
Examiner-in-Chief

William F. Lindquist
Examiner-in-Chief

Thomas E. Lynch
Examiner-in-Chief

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Page 848 F.2d 1245 follows

NOTICE: Federal Circuit Local Rule 47.8(b) states that opinions and orders which are designated as not citable as precedent shall not be employed or cited as precedent. This does not preclude assertion of issues of claim preclusion, issue preclusion, judicial estoppel, law of the case or the like based on a decision of the Court rendered in a nonprecedential opinion or order.

(The decision of the Court is referenced in a "Table of Decisions Without Reported Opinions" appearing in the Federal Reporter.)

John A. BOTT and JAC Products, Inc., Plaintiff/Cross-Appellant,
v.
FOUR STAR CORPORATION, Defendant/Appellant.

Nos. 88-1117, 88-1118.
United States Court of Appeals, Federal Circuit.
May 26, 1988.

E.D.Mich.

AFFIRMED.

Before BISSELL, ARCHER and MAYER, Circuit Judges.

ARCHER, Circuit Judge.

Four Star Corporation ("Four Star") appeals the decisions of the United States District Court for the Eastern District of Michigan, Southern Division, holding that U.S. Patent No. 4,516,710 ('710) granted to John A. Bott and assigned to JAC Products, Inc. (Bott) is not invalid or unenforceable and that Bott is not equitably estopped from enforcing this patent. Bott cross-appeals the finding on summary judgment of no infringement of U.S. Patent Nos. 4,099,658 ('658) and 4,182,471 ('471) by Four Star. We affirm the district court on all issues.

OPINION

I. APPEAL

A. Equitable Safeguards as to Enforcement of '710

Four Star was sued and found to infringe the '658 and '471 patents, relating to certain automobile luggage racks, in an earlier action appealed to this court. Bott v. Four Star Corp., No. 83-1080 (Fed.Cir. March 21, 1984) (unpublished). Four Star then altered its design to avoid infringement of these patents. Thereafter, the '710 patent issued in 1985 and contained claims broad enough to encompass Four Star's redesigned racks. The '710 patent resulted from the seventh application in a series of continuation applications, all based on the identical disclosure and relying for priority on an application filed in 1974. The applications on which the '658 and '471 patents issued were part of this string of continuations.

Four Star contends that patents based on a series of continuation applications should be subject to equitable safeguards if they issue two years after a patent issues on the original disclosure. In support, Four Star relies on ► Webster Elec. Co. v. Splittorf Elec. Co., 264 U.S. 463 (1924). ► See also Crown Cork & Seal Co. v. Ferdinand Gutmann Co., 304 U.S. 159 (1937).

We are not persuaded by Four Star's position because these Supreme Court cases preceded the enactment of the Patent Act of 1952 (Title 35 of the United States Code). Continuation applications are authorized by 35 U.S.C. Sec. 120 (Supp.III 1985). Section 120 does not contain any time limit on broadened claims similar to the two-year time limit applicable to reissue proceedings under 35 U.S.C. Sec. 251 (1982). The latter section expressly provides that a reissued patent shall not be granted enlarging the scope of the claims of a patent unless it is applied for within two years of the grant of the original patent. Had the legislature intended any such time limit to apply to continuation applications it could have included a similar provision in section 120. Moreover, we have not been directed to anything in the legislative history of the 1952 Act that supports Four Star's contention that the equitable considerations discussed in the Supreme Court cases relied on by Four Star should have continued viability.

Accordingly, we are not persuaded by Four Star's argument that this court should adopt equitable safeguards to limit continuation applications when the Congress gave no indication that it intended to so do. See In re Hogan, 559 F.2d 595, 604 n. 13, 194 USPO 527, 536 n. 13 (CCPA 1977) ("The 24 years of pendency herein may be decried, but a limit upon continuing applications is a matter of policy for the Congress, not for us."); In re Henriksen, 399 F.2d 253, 262, 158 USPO 224, 231 (CCPA 1968) (application depended on another filed twenty years earlier).

B. Equitable Estoppel as to the Enforcement of '710

Four Star's argument that Bott should be equitably estopped from enforcing the '710 patent is without merit. The district court made specific findings that Four Star had not established the essential elements required for estoppel, and Four Star has not demonstrated that the court's findings are clearly erroneous or that its conclusions are otherwise in error. Accordingly, the district court's decision on estoppel is affirmed.

Page 848 F.2d 1245_ follows

C. Violation of 37 C.F.R. Sec. 10.18

Four Star's argument that the '710 patent should be unenforceable because of a violation of 37 C.F.R. Sec. 10.18 is also without merit. Four Star has only alleged generally that this rule was violated but has not set forth facts to support any specific violation.

D. Double Patenting

Four Star argues that the '710 patent is invalid for statutory double patenting, citing In re Blattner, 245 F.2d 491, 494, 114 USPO 299, 301 (CCPA 1957), for the proposition that generic claims cannot issue later than species claims. Because the '710 claims are not generic but merely a broadening of the claims of the '658 and '471 patents, Blattner is inapposite and Four Star's contention is rejected.

E. Unenforceability for Inequitable Conduct

Four Star argues that the '658, '471, and '710 patents are unenforceable for inequitable conduct in connection with the prosecution of the '710 patent before the PTO. Even if this issue had been considered by the district court, which is not clear from the record, it is raised on appeal for the first time in Four Star's reply brief. This is in contravention of Fed.R.App.P. 28(c) which specifies that "[t]he appellant may file a brief in reply to the brief of the appellee." (Emphasis added.) Thus, new issues may not be raised in the reply brief. Moreover, Four Star's reply brief is completely devoid of citations to the record to support its contentions on this issue.

II. CROSS-APPEAL

A. Infringement of the '471 and '658 Patents

Bott contends that the district court improperly granted summary judgment that the redesigned racks of Four Star do not infringe the '471 and '658 patents. We are not persuaded by Bott's argument that there were material facts in dispute. In its infringement analysis the district court was required merely to interpret the claims at issue, a question of law, ► Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1054, 5 USPQ2d 1434, 1441 (Fed.Cir.1988), to determine whether removability with the aid of a screwdriver was covered by the claims. There was no factual dispute regarding how the accused racks could be removed, nor that there would be no infringement, either literally or under the doctrine of equivalents, if the claims, properly interpreted, did not encompass removal with the aid of a screwdriver. Accordingly, summary judgment was properly granted on these issues.

EXHIBIT B